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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/206,852	12/08/1998	RICHARD F. ALLISON	6550000028	6041

7380 7590 07/15/2005

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EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/206,852

Applicant(s)

ALLISON ET AL.

Examiner

Anne Marie Grunberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-13,16 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-13,16 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

It is noted that the amended claims received 4/25/05 have the application number 09/698,106. This appears to be in error and has been filed in the present application 09/206,852.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 recites the limitation "the plasmid vector" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 and dependent claims 3, 5-13, 21 and 23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a plasmid vector having a T-DNA region and border sequences, does not reasonably provide enablement for any type of DNA. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Songstad states at the bottom of page 9 that part of the resistance of plant tissue is due to the distance between the cathode and the anode. At the top of page 10, Songstad continues that two electrodes need to be placed as close together as possible in order to lower resistance. The

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present claims state that meristematic tissue and the root such as is shown in Figure 1 are used for the placement of electrical leads. This is quite a distance and resistance as is taught in Songstad keeps any DNA, absent T-DNA regions, from migrating into the plant without significant tissue damage. Indeed, in the working example in the specification, T-DNA regions are used to achieve DNA migration without significant tissue damage.

Claim Rejections - 35 USC § 102

Claims 16 and 20 are newly rejected under 35 U.S.C. 102(e) as being anticipated by Hartman et al.

Claims 16 and 20 are directed to stably transformed transgenic plants that contain a gene for barley oxalic acid oxidase. Hartman et al teach such a plant (see claim 8). These claims are product by process claims. The plant made by a new method that does not distinguish the product made is not novel.

Claim Rejections - 35 USC § 103

Claims 1, 3, 5-13, 16, 20-24 are newly rejection due to amendment or remain rejected under 35 U.S.C. 103(a) as being unpatentable over Burchi et al in view of Bidney et al for the reasons discussed in the previous office action.

It appears that a typographical error exists as to the patent number of Bidney et al. The correct number is 6,166,291. The arguments are discussed in so far as they

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pertain to Burchi et al in view of Bidney et al. Applicant argues that the present invention is drawn to a mature intact plant or seedling wherein a single Ti-plasmid is used in combination with electrophoresis. They point out that they do not use 1) an explant, 2) a binary system, 3) co-cultivation of an explant with agrobacterium, and 4) wounding of the plant by microprojectile bombardment. Additionally they argue that there is no motivation to combine and no reasonable expectation of success.

These arguments have been carefully considered but are not persuasive for the following reasons. Burchi et al also use a mature intact plant (page 164, column 1, under "Plant material"). They also use a plasmid vector that is electrophoresed into the plant (page 164, column 1, under "Plasmids"). Although they do not use a plasmid vector having a "T-DNA region and border sequences", it would have been obvious to use any type of vector, including the vector taught by Bidney et al at column 13, lines 55-67, wherein the Ti plasmid of *A. tumefaciens* is the most widely utilized method for introducing an expression vector. Applicant is arguing a non-existent claim limitation in stating that they do not teach a "binary" system that necessitates the use of a "helper" plasmid. There is nothing in the claim language that excludes a binary system. Due to the open ended claim language, and due to the fact that Burchi et al basically teach the invention with the exception as to the choice of plasmid vector and given the fact that Bidney et al describe the plasmid vector derived from T-DNA as belonging to a list of obvious promoters to use to express a particular gene (column 12, lines 24-50), it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to use any promoter. Bidney et al specifically used for example, a pPHP7746 plasmid

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that contains a pBin19 backbone with two plant transcription units between TDNA borders (column 19, lines 55-65).

No claim is allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

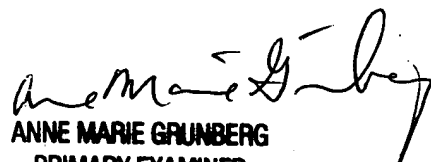
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grunberg whose telephone number is 571-272-0975. The examiner can normally be reached on Monday - Friday 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ANNE MARIE GRUNBERG
PRIMARY EXAMINER